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10/068,438	02/06/2002	Hiroaki Yamamoto	020357 085P2	9528

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 01/12/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/068,438

Applicant(s)

YAMAMOTO, HIROAKI *eb12*

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### **RESPONSE TO AMENDMENT**

1. Claims 1-6 are pending in the application. Claims 7-11 have been cancelled.
2. Amendments to the specification in paper 10, filed on November 3, 2003, have been entered in the above-identified application.

### ***WITHDRAWN REJECTIONS***

3. The objection to the specification, made of record in paper #9, mailed July 30, 2003, page 2, paragraph #2 have/has been withdrawn due to Applicant's amendment in paper #10.

### ***REJECTIONS REPEATED***

4. The 35 U.S.C. §102 rejection of claims 1-6 over Hirose (US Patent No. 6,171,543) is repeated for reasons previously made of record in paper #9, pages 2-4, paragraph #4.

Hirose discloses a rocker panel comprising a plastic automotive part (references #230, 232 and 234) and a clip house member (references #246, 244 and 242) connected to said part, said plastic automotive part comprising a top show surface (references #230 and 232) and a side show surface (reference # 234) connected to said top show surface and extending away from said top show surface from a junction (reference #263) formed between said top show surface and said side show surface, said clip house comprising a first support member (reference #244) connected to said automotive part at said juncture (see figure 3). The juncture (reference #263) comprises a rib (reference #262) with a channel (reference #260) formed therein. The clip house further comprises a second support member (reference #242), said second support member

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connected to said top show surface at a location spaced from said juncture. Said clip house further comprises a web (reference #246) connecting said first support member and said second support member.

The limitation “said house member being adapted to provide a mounting attachment to secure said automotive part to a corresponding mounting member of an automotive structural part” in claim 1 is a functional limitation(s). As defined in the MPEP, “[a] functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)” - MPEP § 2173.05(g). However, the examiner notes that “where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an *inherent characteristic of the prior art*, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on” (emphasis added) - MPEP § 2183.

*Sum* In the instant case, the claimed limitation(s) “said <sup>clip</sup> house member being adapted to provide a mounting attachment to secure said automotive part to a corresponding mounting member of an automotive structural part” is a functional limitation(s) and is deemed to be an inherent characteristic of the prior art since the prior art is substantially identical in composition and/or structure. The examiner’s ~~sound~~ basis for this assertion is ~~based on~~ Kreis having the same structure.

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Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation “unitary molded structure” in claim 5 is a method of production and therefore does not determine the patentability of the product itself.

5. The 35 U.S.C. §103 rejection of claims 1-6 over Kreis (US Patent No.5,609,004) in view of Vollrath (US Patent No.4,850,638) is repeated for reasons previously made of record in paper #9, pages 5-8, paragraph #6.

Kreis discloses a body frame part of an automobile (see the field of the invention) comprising an automotive part (reference #6) and a clip house member (reference #15) connected to said part, said plastic automotive part comprising a top show surface (the outer

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wall, reference #6, on the right hand side of the figure) and a side show surface (the outer wall, reference #6, at the bottom of the figure) connected to said top show surface and extending away from said top show surface from a junction (reference #14) formed between said top show surface and said side show surface, said clip house comprising a first support member (the part of reference #15 which extends from reference #14) connected to said automotive part at said juncture (see figure 1). The juncture (reference #14) comprises a rib with a channel formed therein. The clip house further comprises a second support member (the part of reference #15 which extends to the upper right hand corner of the outer wall reference #6), said second support member connected to said top show surface at a location spaced from said juncture. Said clip house further comprises a web (the part of reference #15 which extends to the left side of the outer wall reference #6) connecting said first support member and said second support member.

The automotive part (reference #6) can further be seen to have a substantially planar horizontal top portion (the outer wall, reference #6, on the right hand side of the figure) with first and second longitudinally extending edges a side portion (the outer wall, reference #6, at the bottom of the figure) with a longitudinally extending edge connected to said longitudinally extending edge of said top portion, a longitudinally extending reinforcing rib (reference #14) with first and second foot portions connected such that said foot portion is attached to said top portion near said first edge of said top portion and said second foot portion is attached to said side portion near said edge that a longitudinally extending hollow channel is defined and said clip house mounting structure (reference #15) further comprises a clip mounting member with an upper portion (the part of reference #15 which extends to the upper right hand corner of the outer wall reference #6) attached to said second longitudinally extending edge of said top portion and a

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lower portion attached to said reinforcing rib (the part of reference #15 which extends from reference #14). The clip house mounting structure further comprises a structural support member with first and second ends and is attached such that said first end connects to said lower portion of said mounting member and said second end connects to said reinforcing rib (reference #15). The clip house further comprising a web portion connected to said clip mounting member the part of reference #15 which extends to the left side of the outer wall reference #6). See the figure.

*SMW* Kreis disclose<sup>s</sup> all the limitations of the instant claimed invention except that ~~the~~ *its* automotive part is made of metal instead of the instant claimed plastic.

Vollrath discloses a body frame part of an automobile. Vollrath further teaches that it is considerably cheaper if these parts are formed as plastic mouldings or light metal castings, which is preferable, since by this means a good dimensional accuracy of these parts is obtained, and in consequence the bodywork can be assembled so as to be completely free of distortion and stress and the signs of fatigue which can usually be observed because of internal stress are avoided

(col. 1, lines 37-61).

*THE REFERENCES ARE ANALOGOUS BECAUSE THEY BOTH TEACH BODY FRAME PARTS.*

*SMW* It would have been obvious to one of ordinary skill in the art at the time of the invention *SMW* to use <sup>*VOLLRATH'S*</sup> plastic for the automotive part of Kreis because Vollrath teaches that plastic mouldings or light metal castings are considerably cheaper and have good dimensional accuracy.

The preamble in claim 6, "rocker panel," is an intended use of the combination of the plastic automotive part and a clip house member and does not add structure to the body of the claim.

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The limitation “said house member being adapted to provide a mounting attachment to secure said automotive part to a corresponding mounting member of an automotive structural part” in claim 1 is a functional limitation(s). As defined in the MPEP, “[a] functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)” - MPEP § 2173.05(g). However, the examiner notes that “where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be a *necessarily present characteristic of the prior art*, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on” (emphasis added) - MPEP § 2183.

In the instant case, the claimed limitation(s) “said house member being adapted to provide a mounting attachment to secure said automotive part to a corresponding mounting member of an automotive structural part” is a functional limitation(s) and is deemed to be a necessarily present of the prior art since the prior art is substantially identical in composition and/or structure. The examiner’s sound basis for this assertion is based on Kreis having the same structure.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to



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present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation “unitary molded structure” in claim 5 is a method of production and therefore does not determine the patentability of the product itself.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

6. Applicant's arguments in paper #10 regarding the 35 U.S.C. §102 rejection over Hirose of record have been carefully considered but are deemed unpersuasive.

Applicant argues that “‘show surfaces’ are referred to in the specification at paragraph 2 and are well known in the automotive trim part field.” The only recitation of “show surfaces” in paragraph 2 of the specification is, “ In such film lamination techniques, a paint film laminate is co-molded over an external show face surface of the plastic part.” This passage merely seems to indicate that the plastic part has a surface that is called a “show face surface,” more specifically in the passage the external surface of the plastic part. The claims must be given their broadest

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reasonable interpretation and the words of a claim must be given their “plain meaning” unless they are defined in the specification MPEP §2111 and §2111.01. Since paragraph 2 of the specification does not define “show surfaces” the term is given its broadest reasonable interpretation that it is a surface on the plastic part that extends away from the junction.

Applicant argues that “the junction recited in claim 1 extends longitudinally between the top and side portions of the part to provide increased flexibility to the part and to minimize sagging in the part.” These limitations are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. It is further note that claim 1 does not recite how the top or side surfaces extend from the juncture, i.e. what direction or angle.

Applicant argues that the Examiner’s “construction inappropriately redefines that rocker panel of Hirose to mirror that which is claimed in Applicant’s invention, whereas in fact Hirose wholly fails to teach the features of the juncture and hollow channeled reinforcing rib between the top and side portions of the part as recited in claims 1 and 2.” As discussed above, claims must be given their broadest reasonable interpretation and the words of a claim must be given their “plain meaning” unless they are defined in the specification. Since the specification does not give any specific definition to the terms “top show surface” and “side show surface” they are give their plain meaning. According claim 1 the “top show surface” and the “side show surface” are surfaces that are connected at a juncture and extend away from that juncture. Hirose clearly shows two surfaces extending away from a juncture in figure 3. Furthermore, from figure 3 it can be seen that the top portion 230 and front portion 232 in Hirose are part of a continuous surface that has bend it and that the surface originates from the juncture 263.

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7. Applicant's arguments in paper #10 regarding the 35 U.S.C. §103 rejection over Kreis in view of Vollrath of record have been carefully considered but are deemed unpersuasive.

Applicant's arguments regarding the rejection over Kreis in view of Vollrath also deal with the construction of the claim. These arguments have already been addressed above.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (571) 272-1498. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (571) 272-0987.

ac

1/9/04



*Sandra M. Nolan*  
SANDRA M. NOLAN  
PRIMARY EXAMINER

1-12-04